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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

THOMAS E SISSON  
JACKSON WALKER  
112 E PECAN STREET SUITE 2100  
SAN ANTONIO TX 78205

DEXTER

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

09/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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<b>Office Action Summary</b>	Application No. <b>09/380,351</b>	Applicant(s) <b>Eddy et al.</b>
	Examiner <b>Clark F. Dexter</b>	Group Art Unit <b>3724</b>

Responsive to communication(s) filed on Aug 30, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 26-50 is/are pending in the application.

Of the above, claim(s) 27-33, 38-47, and 50 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 26, 34-37, 48, and 49 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group III (claims 26, 34-37, 48 and 49) in the response filed August 30, 2000 (paper no. 5) is acknowledged. Claims 27-33, 38-47 and 50 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on March 4, 1997. It is noted, however, that a certified copy of the British application has not been received.

### ***Drawings***

3. The drawings are objected to because of the following informalities:

In Figure 5, it seems that numeral 12 with an arrowheaded lead line should be added for clarity.

In Figure 6, the lead line for numeral 32 is inaccurate and should be extended to the slot; also it is requested that numeral 27 be added for clarity.

Appropriate correction is required.

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*Abstract*

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

*Specification*

5. The disclosure is objected to because of the following informalities:

On page 6, line 9, it is not clear as to what disclosed structure "electric motor" refers, and it seems that a numeral or --(not shown)-- should be inserted after "electric motor" for clarity; similarly, in lines 10 and 11, a numeral or --(not shown)-- should be inserted after "pinion" and "gear box", respectively, for clarity; in line 25, it is not clear as to what disclosed structure "electric or hydraulic motor" refers, and it seems that --(not shown)-- should be inserted after "electric or hydraulic motor" or the like for clarity.

On page 7, line 23, it is not clear as to what disclosed structure "suitable means" refers, and it seems that a numeral or --(not shown)-- should be inserted after "suitable means" or the like for clarity.

On page 9, line 2, "9a" appears to be inaccurate, and it seems that it should read --9b--; in line 3, "9b" appears to be inaccurate, and it seems that it should read --9a--.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

6. Claims 26, 34-37, 48 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, lines 5-6, the phrase "extends in a direction substantially parallel to said substantially longitudinal axis of said elongate member" renders the claim vague and indefinite since the invention, specifically the support means, is being defined in terms of the elongate member which is not part of the claimed device.

In claim 37, lines 1-2, the phrase "arranged to exert a downward pressure on a part of an elongate member being cut" is vague and indefinite as to how the roller is arranged, particularly since it is defined in terms of the elongate member which is not part of the claimed invention; in line 2, "an elongate member" is vague and indefinite as to its relationship with the previously recited elongate member, and it seems that "an" should be changed to --said-- or the like.

In claim 48, line 8, "an elongate member" is vague and indefinite as to whether it refers to the elongate member previously set forth or to another such elongate member.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 26, 34-36, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutina in view of Lindstrom.

Dutina discloses a device and process with almost every structural limitation and step, respectively, of the claimed invention but lacks a specific showing of support means extending upstream and downstream of the separation unit. However, the Examiner takes Official notice that such support means are old and well known in the art for supporting a workpiece as it approaches a workstation, as it goes through a workstation and as it passes from a workstation as a finished product (i.e., finished with respect to that workstation). An example of such a support means is disclosed by Lindstrom. Therefore, it would have been obvious to one having ordinary skill in the art to provide support means on the device Dutina (and thus in the process of using the device of Dutina) for the well known benefits including that described above.

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9. Claim 37, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dutina in view of Lindstrom as applied to claim 26 above, and further in view of Masse.

The combination lacks a roller as claimed. However, the Examiner takes Official notice that such pressure rollers are old and well known in the art and provide the well known benefit of preventing a workpiece to move upwardly away from a cutting blade and possibly out of its intended path through a cutting device thus providing various known benefits including providing a cleaner cut as well as increasing the safety of operating the cutting device. An example of such a pressure roller is disclosed by Masse. Therefore, it would have been obvious to one having ordinary skill in the art to provide a pressure roller in the device of Dutina for the well known benefits including that described above.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



**Clark F. Dexter  
Primary Examiner  
Art Unit 3724**

cfd  
September 25, 2000